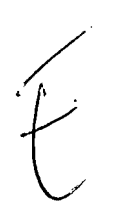


REMARKS

Claims 1, 6, and 17 are amended, and claims 4, 5, 9-12, 14, 38, 39, and 42 are canceled, without prejudice. Therefore, claims 1, 6, 15-17, 35-37, 43, and 44 remain pending in the application. Reexamination and reconsideration of the pending claims is respectfully requested in view of the foregoing amendments and accompanying remarks.

Claims 1, 5, 15-17, and 35-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya '576 in view of Eggers '314. Responsive to the rejection, an extensive effort has been made to amend the claims to more particularly define the invention, in an earnest attempt to conclude the lengthy prosecution of this application. Accordingly, claim 5 has been canceled, together with all other non-elected claims which do not depend from elected claims. Additionally, claim 1 has been amended to include the limitations of claim 14, which presumably avoids this basis for rejection (claim 14 was rejected based upon Komiya in view of Eggers, and further in view of Kirsch et al., which is discussed hereinbelow). Since claims 6, 15-16, and 35-37, as well as new claim 45 (equivalent to old claim 17) depend upon claim 1, these claims also avoid the foregoing rejection. It is noted that claim 17 has been rewritten in independent format. This claim recites a marking device which comprises a discrete marker element, and an apparatus for remotely delivering the marker element to a particular tissue area. Even assuming, *arguendo*, that the Examiner has properly interpreted the Komiya patent as disclosing all of the claimed features of the recited apparatus, though no interpretation of the Komiya device, as it relates to the limitations concerning the recited apparatus is provided, Komiya clearly does not utilize a medical instrument which draws a vacuum to isolate and retain tissue at the selected tissue location, wherein the marking device is adapted to deploy the marker element into the retained tissue, as recited in claim 17 (see page 14, lines 10-14 of the specification, for



example).

This grounds for rejection is unclear, because it continues to refer to the Isse patent, which is not prior art, for reasons explained in the last response. If the Examiner persists with this ground for rejection, he is respectfully requested to issue another non-final office action properly setting forth its basis.

Additionally, it appears that the Examiner has misinterpreted the Eggers patent. It does not appear to disclose an endoscope (sic) which deliver other devices such as the one disclosed by Komiya to the surgical site. Rather, Eggers discloses an endoscopic probe, which needs itself to be delivered through a trocar or the like into a patient's body. Thus, the rejection of claim 17 is untenable. There is no way, absent reference to Applicant's disclosure using hindsight reconstruction, that one of ordinary skill in the art would be led by the teachings of the prior art to utilize the endoscopic probe of Eggers in combination with the Komiya device. They are intended for vastly different types of procedures, and one would still need to employ yet another device having a working channel for gaining access to the procedural site. Furthermore, even if one did serendipitously use the Eggers device in conjunction with the Komiya device, the ostensible purpose of the vacuum feature for the Eggers device is to provide suction for evacuating debris caused by a procedure; ie. bits of tissue, blood and the like. There is no teaching by Eggers of employing vacuum to draw tissue to be marked to the distal end of a marking device, so that a marking element can be easily deployed thereinto, as recited in claim 17. Therefore, claim 17 is clearly allowable over the combination of Komiya and Eggers.

Claims 14, 44, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komiya, Eggers, and Kirsch et al. Initially, since there are more than one Kirsch et al. patent of record, the Examiner is respectfully requested to issue another non-final office action clarifying which patent is being relied upon if he determines to maintain this basis for rejection. However, claim 1, as amended, which



includes the limitations of claim 14, is clearly allowable over this combination of references. First, as noted supra, the Examiner has apparently misinterpreted the Eggers patent as including an instrument working channel, though it does not appear to include such a channel. Thus, the Eggers device could not, in fact, be used to deliver the Komiya device to the procedural site, and the Examiner's rejection is therefore improper and should be withdrawn. Furthermore, there would have been no motivation for one to have "used the deployment actuator mechanism of Kirsch et al. in Komiya, absent reference to Applicants' disclosure. Structurally, they are entirely different in operation, and one would need to replace practically the entire deployment structure of Komiya with that of Kirsch et al. to effect the change. However, to do so would be to destroy the function of Komiya, which is to incorporate a structure which permits, by virtue of a unique interaction of elements, the clip member 11 to become much wider than the delivery tube 21, so that it can clip a large tissue portion 22 to be clamped (Figs. 6 and 7). Essentially, the only proper approach the Examiner could take is to reject the claims based upon the Kirsch et al. patent. However, clearly, the claims are distinguished over Kirsch et al.

In view of the foregoing amendments, and supporting remarks, Applicants respectfully submit that the application is now in condition for allowance over the prior art of record, and early notification of same is earnestly solicited. Should there remain further issues to be addressed, the Examiner is respectfully requested to contact the

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undersigned at the below listed number.

Respectfully submitted,

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CERTIFICATE OF MAILING

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